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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/672,185	09/26/2003	Lanny L. Johnson	Johnson 4.1-1	9836
21036	7590	10/05/2004	EXAMINER	
MCLEOD & MOYNE, P.C. 2190 COMMONS PARKWAY OKEMOS, MI 48864			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,185	<b>Applicant(s)</b> JOHNSON, LANNY L.	
	<b>Examiner</b> Stephen L. Blau	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8-10, 13, 15, 19 and 22-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 11, 12, 14, 16-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/26/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to a putter, classified in class 473, subclass 340.
  - II. Claims 25-26, drawn to a method of stroking, classified in class 473, subclass 409.
  - III. Claims 27-29, drawn to a method of fitting a putter to a golfer, classified in class 473, subclass 409.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of a putter and a method of stroking are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a materially different process can be used as putting only once.

Inventions of a putter and a method of fitting a putter to a golfer are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another

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and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process as fitting a putter to a player where the putter does not have adjustable features.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and II, restriction for examination purposes as indicated is proper.

4. If group I claims are elected, this group of claims contains claims directed to the following patentably distinct species of the claimed invention:

Type of Head

- a. Species 1 (Fig. 1):
- b. Species 2 (Figs. 9B-9C):
- c. Species 3 (Fig. 10):
- d. Species 4 (Fig. 13):
- e. Species 5 (Fig. 17):
- f. Species 6 (Fig. 21):
- g. Species 7 (Fig. 25A):
- h. Species 8 (Fig. 25B):
- i. Species 9 (Fig. 25C):
- j. Species 10 (Fig. 26):
- k. Species 11 (Fig. 29):

l. Species 12 (Fig. 32):

m. Species 13 (Fig. 33):

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it is not known what claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. During a telephone conversation with Mr. Ian C. McLeod (Reg. No. 20,931) on 27 September 2003 a provisional election was made without traverse to prosecute the invention of a putter of figure 1, claims 1-3, 5-7, 11-12, 14, 16-18 and 20-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4, 8-10, 13, 15, 19, and 22-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Information Disclosure Statement***

6. The information disclosure statement filed 26 September 2003 fails to comply with 37 CFR 1.98(a)(1), which requires a date of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-7, 11-12, 14, 16-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 8-150233.

8-150233 discloses a first linear edge able to align to a ball along a horizontal plane (Fig. 3), a striking face curved with a radius of curvature less than a radius of a ball (Fig. 2b), a face able to strike a ball at, above or below a median of a ball (Fig. 4), a runner (Ref. No. 3), a shaft is mounted adjacent the first linear edge (Fig. 5), a striking face is less than about 6.4 mm thick between the sides to define the first linear edge (English Abstract), and a bottom of a head provided with a convexly rounded circular protrusion as a runner (Fig. 5). 8-1500233 does not disclose the runner being a semi-sphere but clearly an artisan skilled in the art of using a sphere shape as a runner would have selected a suitable sphere shape in which a semi-sphere shape is included.

8-150233 lacks a shaft with a grip at a proximal end, a head being metal, and a runner being semi-circular.

Jacobson discloses a grip at a proximal end of a shaft (17), a head being metal (Col. 3, Lns. 3-12) and runners being semi-circular (Fig. 4). In view of the patent of Jacobson it would have been obvious to modify the putter of 8-150233 to have a grip a grip at a proximal end in order to provide comfort to a players hands while gripping a shaft. In view of the patent of Jacobson it would have been obvious to modify the putter of 8-150233 to have a head being metal in order to maximize the amount of weight and transfer of energy at impact. In view of the patent of Jacobson it would have been obvious to modify the putter of 8-150233 to have a runner being semi-circular in order to be able to rest the head on the ground closer to the median of a golf ball.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 28 September 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**